

RESPONSE TO NON-FINAL OFFICE ACTION

Atty. Dkt. No. P-5430P1

U.S. Serial No.: 10/776,643

Filing Date: 12 February 2004

Title: Binding Proteins as Biosensors

REMARKS

A New Declaration is Not Required

Applicants remind the Examiner that “[t]he Office no longer checks the date of execution of the oath or declaration and the Office will no longer require a newly executed oath or declaration based on an oath or declaration being stale ... or where the date of execution has been omitted.” MPEP §602.05. Accordingly, a new declaration is not required.

The Objection to Claim 57 Should be Withdrawn

Applicants remind the Examiner that the application does not contain a sequence listing, thus a reference to a “SEQ ID NO” in claim 57 would be inappropriate. Applicants have amended claim 57 to recite that the glucose/galactose bind protein (GGBP) is the *E. coli* GGBP. Applicants thank the Examiner for the suggestion to clarify claim 57.

The Enablement Rejection Should be Withdrawn

The Office Action of 19 August 2008 rejected claims 57, 78 and 79 because the specification allegedly fails “to enable one skilled in the art to ... to make and/or use the invention.” *Office Action*, page 4. Applicants respectfully disagree. Regardless, Applicants have amended claim 57 to better capture the envisioned commercial embodiments and assert that the amendments render moot the enablement rejection. Namely, claim 57 now recites that the GGBP is from *E. coli*, which was well-known in the art as of the filing date of the application. *See* paragraph 0025 of the present application. And “a patent need not teach, and preferably omits, what is well known in the art.” *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986). Applicants respectfully request reconsideration and withdrawal of the enablement rejection.

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CONCLUSION

Applicants have amended claim 57 to better capture the envisioned commercial embodiments and assert that the amendments render moot the enablement rejection. Applicants respectfully request reconsideration and withdrawal of the enablement rejection and the objection to claim 57.

Should the Examiner believe that further discussion of any remaining issues would advance the prosecution, he or she is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date 18 November 2008

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